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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/123,109 | 07/27/1998 | JAMES DUKE BOND | RIC-97-120 | 5163 |
| 25537 | 7590 | 12/16/2005 | | |
| MCI, INC 1133 19TH STREET NW 4TH FLOOR WASHINGTON, DC 20036 | | | EXAMINER GAUTHIER, GERALD | |
| | | | ART UNIT 2645 | PAPER NUMBER |

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/123,109

Applicant(s)

BOND ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14 and 16-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 and 16-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/14/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2005 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim(s) 1-8, 10-14 and 16-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al. (US 5,912,956) in view of Small (US 5,513,117) and in further view of Brown et al. (US 5,333,180).

Regarding **claim(s) 1, 10, 16 and 19**, Longo discloses a system for recording a personal greeting associated with a pre-paid telephone calling card (column 1, lines 8-24), comprising:

a data storage system for storing data corresponding to a pre-paid telephone calling card and a personal greeting related to the pre-paid telephone calling card (column 4, lines 45-54) [The memory device included in the controller 24 stores data of a calling card and messages inputted by the subscriber]; and

a pre-paid telephone calling card processing system coupled to the data storage system and configured to receive a request to record the personal greeting during a calling card setup call over a telephone network and to cause the personal greeting to be recorded during the calling card setup call (column 5, lines 49-66) [The system 20

allows the subscribers with a master control calling cards and a master control pins to set calling card using the telephone and leave a personal greeting for the caller with the calling card].

Although, Longo discloses a calling card with a personal greeting to the recipient but fails to disclose the pre-paid telephone calling card processing system plays, without input by a user to request the playback, the personal greeting upon use of the pre-paid telephone calling by the user.

However, Small, in the same field of endeavor, teaches the pre-paid telephone calling card processing system plays, without input by a user to request the playback, the personal greeting upon use of the pre-paid telephone calling by the user (FIG. 12 and column 8, lines 43-48).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Longo using the system server as taught by Small.

This modification of the invention enables the system to play without input by a user to request the playback; the personal greeting upon use of the pre-paid telephone calling by the user so that the system would provide an improved apparatus for generating personalized greeting cards.

Longo in combination with Small fails to disclose maintaining the status of whether said personal greeting has been played.

However, Brown teaches maintains status of whether said personal greeting has been played (Table 700 and column 10, lines 23-27).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Longo in combination with Small using the teaching of a status table as taught by Brown.

This modification of the invention enables the system to maintain a status of whether said personal greeting has been played so that the system would provide to the user the status of the messages being delivered.

Regarding **claim(s) 2 and 20**, Longo discloses the data storage system and the pre-paid calling card processing system are remotely located (column 4, lines 24-44).

Regarding **claim(s) 3, 11, 21 and 28**, Longo discloses the data corresponding to the pre-paid telephone calling card includes a quantity corresponding to a number of service units available to be used to make at least one call in relation to the pre-paid telephone calling card (column 4, lines 24-44).

Regarding **claim(s) 4, 12 and 22**, Longo discloses the call is a long distance telephone call (column 4, lines 55-66).

Regarding **claim(s) 5, 13, 23 and 29**, Longo discloses the service units correspond to telephone call service minutes (column 5, lines 49-66).

Regarding **claim(s) 6, 14 and 24**, Longo discloses the pre-paid telephone calling card processing system causes the personal greeting to be recorded within the data storage system in accordance with a card identifier corresponding to the pre-paid telephone calling card (column 4, lines 24-44).

Regarding **claim(s) 7 and 25**, Longo discloses a voice data storage facility coupled to the pre-paid telephone calling card processing system and to the data storage system, and operative to store the personal greeting based on a card identifier corresponding to the pre-paid telephone calling card (column 4, lines 24-44).

Regarding **claim(s) 8 and 26**, Longo discloses a voice response system coupled to the pre-paid calling card processing system and configured to prompt a caller to record the personal greeting via at least one voice prompt during the setup call over the telephone network (column 5, lines 23-48).

Regarding **claim(s) 17**, Longo discloses the personal greeting is stored in a data storage system in accordance with the card identifier (column 4, lines 45-54).

Regarding **claim(s) 18**, Longo discloses the telephone network is the publicly switched telephone network (column 4, lines 24-44).

Regarding **claim(s) 27**, Longo in combination with Small and Brown discloses all the limitations of **claim(s) 27** as stated in **claim(s) 1**'s rejection above and furthermore Longo discloses receiving a request to make an outbound telephone call in relation to the pre-paid telephone calling card during an access call over a telephone network (column 5, lines 49-66) [The caller is able to make an outbound call through the system after input a pin number associated with the calling card therefore limiting calls for the teenagers using the telephone calling card].

Regarding **claim(s) 30**, Longo discloses the personal greeting stored during the causing step is to be played back automatically during an access call related to the pre-paid telephone calling card (column 5, lines 23-48).

Regarding **claim(s) 31**, Longo discloses a method of using a pre-paid telephone calling card (column 1, lines 7-24) comprising the steps of:

accessing a prepaid telephone calling card processing system during a telephone service access call via a telephone network (column 5, lines 23-48) [The caller access the system 20 via a telephone network using a toll free number];

entering a card identifier corresponding to data addressable by the pre-paid telephone calling card processing system (column 5, lines 23-48) [The caller enters the pin number in the face of the card associated with the system 20];

retrieving a pre-recorded greeting associated with the pre-paid telephone calling card based on the card identifier entered during the entering step (column 5, lines 23-

48) [The caller has the option after accessing the system to retrieve a prerecorded message].

Although, Longo discloses a calling card with a personal greeting to the recipient but fails to disclose playing, without prompting, the pre-recording personal greeting during the telephone access service access call.

However, Small, in the same field of endeavor, teaches playing, without prompting, the pre-recording personal greeting during the telephone access service access call (FIG. 12 and column 8, lines 43-48).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Longo using the system server as taught by Small.

This modification of the invention enables the system to play without input by a user to request the playback, the personal greeting upon use of the pre-paid telephone calling by the user so that the system would provide an improved apparatus for generating personalized greeting cards.

Longo in combination with Small fails to disclose maintaining the status of whether said personal greeting has been played.

However, Brown teaches maintains status of whether said personal greeting has been played (Table 700 and column 10, lines 23-27).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Longo in combination with Small using the teaching of a status table as taught by Brown.

This modification of the invention enables the system to maintain a status of whether said personal greeting has been played so that the system would provide to the user the status of the messages being delivered.

Regarding **claim(s) 32**, Longo discloses the step of entering a terminating telephone number to which an outbound call will be placed automatically after the pre-recorded personal greeting has been played (column 5, lines 23-48).

Regarding **claim(s) 33**, Longo discloses the accessing and entering steps are carried out remotely from the retrieving and playing steps (column 5, lines 23-48).

Response to Arguments

6. Applicant's arguments with respect to **claim(s) 1-8, 10-14 and 16-33** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

Gerald Gauthier
Examiner
Art Unit 2645

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December 8, 2005